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EXAMINER

FADOK, MARK A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/090,906
Filing Date: March 04, 2002
Appellant(s): SCIBORA, MARCO

MAILED

JUL 11 2007

GROUP 3600

Gerald E. Helget
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/9/2007 appealing from the Office action mailed 8/10/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 10,19,20 and 21 appears on page 7-10 of the Appendix to the appellant's brief. The minor errors are as follows: Claims are not designated with the status. For status please refer to claims received 5/18/2006.

(8) Evidence Relied Upon

20030109944	Ritz et al	0602003
5,237,157	Kaplan	08-1993

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10,19,20 and 21, rejected under 35 U.S.C. 103(a) as being unpatentable over Ritz (2003/0109944) in view of Kaplan (5,237,157).

In regards to claim 10, Ritz discloses an apparatus for allowing a consumer to digitally mark portions of media content and later retrieve the marked portions uniquely keyed to that consumer (abstract), comprising:

- a. storage for storing the media content (FIG 1);
- b. a server computer accessing the media content storage (FIG 1);
- c. a workstation interacting with the server computer to allow the consumer to sample portions of the stored media content (FIG 1);

Ritz teaches collecting identifying information from a user in order to track their usage habits, but does not specifically mention that the identifying information is received on a portable identification means. Kaplan teaches providing a barcode unique to the user to identify the user during a session (col 5, lines 30-40). It would have been

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obvious to a person having ordinary skill in the art at the time of the invention to include in Ritz, identifying information received on a portable identification, because this would allow for quick identification of a user who is not using their own personal device and allowed access to the previews program.

e. an array containing references to the identifying indicia received from the workstation and indicia keyed to selected instances of the sampled portions of the stored media content (FIG 4 and 5).

In regards to claim 11, Ritz teaches wherein the array further comprises indicia of the consumer's identity (FIG 2).

In regards to claims 20 and 21, these are considered parallel claims to claims 10 and 19 above and are rejected for the same reasons.

(10) Response to Argument

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Ritz does not teach a plurality of portable identification means identifying the customer, separate from the server, the workstation and sampled portions, the portable identification means being presented to the work station. The examiner disagrees and directs applicant's attention to 1) user ID and password created at registration of the user (Ritz FIG 7 and 8) and 2) Kaplan's providing a barcode unique to the user to identify the user during a session (col 5, lines 30-40).

Applicant argues that the combination of Ritz and Kaplan does not teach an array containing references to identifying indicia from the portable identification means received from the workstation and keyed to selected instances of the sampled portions of the stored media content. The examiner disagrees and further directs the applicant's attention to FIG 7 and 8 (item 720, 740, 750) and (item 830,840,850) respectively where it is clear that an array as defined in applicant's specification is being created and maintained. Applicant may also wish to review col 5, lines 40-50 of Kaplan where it is clear that an array as defined in applicant's specification is being created and maintained.

In response to applicant's arguments, the recitation "later retrieve the marked portions uniquely keyed to that customer" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). However, for the sake of compact prosecution the examiner directs the applicant to Ritz para 0032-0036, 0045, where it is clear that selections are made from a saved group of songs and that clips can be played of the selected songs (0028).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both of the cited references are from the same field of endeavor which is music selection, storage and replay of stored selection. Applicant questions the motivation provided by the examiner and states that there is a lack of understanding on applicant's part. To clarify examiner was referring in the previously stated motivation that the user when using there personal computer may be automatically identified by a cookie or some other identification that is automatically transmitted to a server from a user computer when a connection is made. This method of identification is a notoriously well know method of identifying a user and is clearly knowledge generally available to one of ordinary skill in the art. With this clarification it becomes clear that Kaplan provides the remainder of the motivation of providing instant access and recognition of the user to the remote device (Kaplan, col 5, lines 30-40)

Further motivation may be found in Ritz where the barcode ID of Kaplan the barcode would be helpfull when a scanner is being used, so that the information such as user name and password need not be manually entered and thus saving time and avoiding errors (Ritz, para 0020).

Applicant argues that the examiner has not shown where “a shopper’s reference database containing references unique to the unique bar codes received from the workstation and references to the sample portions of the stored media content”. The examiner understands this feature to be analogous to the array feature of claim 10 and therefore this feature in claim 20 is rejected for the same reasons supra.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

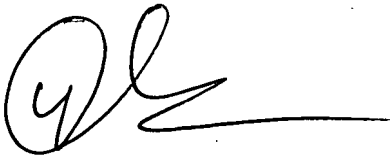
Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a stylized, flowing script.

Mark Fadok

Primary Examiner

Conferees:

A handwritten signature in black ink, appearing to read 'Yogesh Garg', with a stylized, flowing script.

Yogesh Garg

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Naeem Haq

Primary Examiner AU 3625